

REMARKS

Reconsideration and withdrawal of the rejections of the application are requested in view of the amendments and remarks presented herein, which place the application into condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1, 2, and 68-82 are pending in this application. Claims 1, 2, 68, 69, and 72 are amended, and claims 73-82 are added without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

Support for the amendment to the claims can be found throughout the specification and claims as originally filed. The amendment to claim 1 can be found, for example, on page 2 and in original claim 1. The amendment to claims 2, 68, 69, and 72 are to clarify the invention. Support for new claims 73-75 can be found, for instance, in original claim 2, while support for new claims 76 and 77 can be found, for example, in original claim 68. Further, support for new claims 79-81 can be found, for instance, in original claim 69, and support for new claim 81 can be found, for example, in original claim 72. No new matter is added.

It is submitted that the claims are patentably distinct over the prior art and that these claims are and were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTION UNDER 35 U.S.C. § 112 IS OVERCOME

Indefiniteness

Claims 2, 68, 69, and 72 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Office Action contended that recitation of terms such as “preferably” and “especially” renders the claims unclear since it is unclear whether the recitation following these terms are part of the claimed invention.

In response, Applicants draw attention to the instant claims, wherein claims 2, 68, 69, and 72 do not recite terms such as “preferably” or “especially,” and therefore are not indefinite.

Accordingly, Applicants request reconsideration and withdrawal of the rejection under Section 112, second paragraph.

Enablement

Claims 1, 2, and 68-72 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Office Action contended that the specification is not enabling for R, R¹⁰, and T comprising the scope as claimed.

Applicants respectfully disagree. Firstly, Applicants turn to the instant claims, wherein R = OR¹, such that R¹ = alkyl or aryl. Herein, S and U = H, V = OR⁷, R⁷ = COR⁸, and R⁸ = alkyl, alkenyl or aryl. Further, Y = free electron pair, and Z = CH₃ or COR¹¹, wherein R¹¹ = alkyl, CF₃ or aryl. Hence, the scope of the invention is herein clarified and is not owed to a range of as many variables.

Applicants also assert that there is substantial guidance in the specification. For example, there is literal support in the specification for the scope of R, R¹⁰, and T as recited in the instant claims, for example, on page 2. In addition, there is support in the Figures. For instance, while the Office Action alleges that there is only enablement for T = H or OR⁴ where R⁴ = H, Figure 7 (sheet 7/9) clearly shows how derivatives of compounds are prepared wherein R⁴ is a group other than hydrogen. Additional reagents which are necessary to carry out the corresponding reactions are provided at the bottom of Figure 7. Applicants assert that derivations at an aromatic OH-group are within the expertise of one of ordinary skill in the art, and therefore the skilled artisan can make these derivations by the information provided in the specification without undue experimentation. In addition, Figure 1 (sheet 1/9), Figure 2, (sheet 2/9), Figure 3 (sheet 3/9), and Figure 4 (sheet 4/9) disclose how derivatives at group X can be synthesized. Reagents for carrying out the standard synthetic operations are provided at the bottom of the respective figures.

Moreover, Applicants provide a working example in the enclosed Declaration under 37 C.F.R. § 1.132 by Dr. Wolfgang Richter, which demonstrates the claimed invention for the full scope of R. In particular, the Declaration shows experimental data for an ester group at residue R.

For at least the reasons provided above, Applicants assert that the instant claims are enabled by the specification. Accordingly, Applicants request reconsideration and withdrawal of the rejection under Section 112, first paragraph.

III. THE REJECTION UNDER 35 U.S.C. § 102 IS OVERCOME

Claims 1, 68, and 72 were rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Hamel et al. (Curr Med Chem – Anti-Cancer Agents 2002, 2). Claims 1, 68, and 72 were also rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Sasse et al. (J Antibiotics 2000, 53: 879-885). Further, claims 1, 68, and 72 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Hoefle et al. (DE 10008089). These rejections are traversed and will be addressed collectively.

Initially, Applicants respectfully point out that “[a] rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *In re Buszard* 504 F.3d 1364, 1366 (Fed. Cir. 2007) (citing *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001) (“Invalidity on the ground of ‘anticipation’ requires lack of novelty of the invention as claimed . . . that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim.”)). With this in mind, Applicants assert that the cited reference do not anticipate the instant claims, as the cited recited references do not teach each and every limitation of the instantly claimed invention.

Applicants turn to the instant claims, wherein R = OR¹, and R¹ = alkyl or aryl. In contrast, R = OH in Hamel et al., Sasse et al., and Hoefle et al.; none of the cited reference teach or even suggest R = OR¹, wherein R¹ = alkyl or aryl. Hamel et al., Sasse et al., and Hoefle et al. fail to teach each limitation of the instant claims, and thereby do no anticipate the claimed invention.

Accordingly, Applicants request reconsideration and withdrawal of the Section 102 rejections.

CONCLUSION

Applicants believe that the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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